



DORFF.001A

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Victor L. Dorff et al.) Group Art Unit 3624
Appl. No. : 09/749,373)
Filed : December 22, 2000)
For : MULTIPLE LEVEL)
PHILANTHROPIC GIVING)
SYSTEM AND METHOD)
Examiner : Lalita M. Hamilton)

I hereby certify that this correspondence and all marked attachments are being deposited with the United States Postal Service as first-class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on
July 25, 2005
(Date)
Michael A. Gulliana, Reg. No. 42,611

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant hereby submits the following remarks in support of the present Pre-Appeal Brief Request for Review, in connection with the above-captioned application.

REMARKS

Claims 1-14 remain pending in the present application, as noted in the amendment filed November 23, 2004.

Summary of the Subject Technology

One advantage of the inventions recited in the presently pending claims is that by including the step of or means for confirming that a payee or drawee of a check is a qualified charitable institution under the United States Internal Revenue Code, is that a party that purchases or receives such a check as a gift has complete freedom to use the check for any qualified charitable institution. In other words, the checks are not restricted to payment to a limited and/or predetermined number of charitable institutions. Rather, the checks can be used to make a donation to any party that is a qualified charitable institution under the United States Internal Revenue Code.

Presently, there are hundreds of thousands of such qualified charitable institutions (Page 1, lines 13-15 of the present specification). Additionally, the list of qualified charitable

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institutions changes often. Thus, by including the step of or means for verifying that the payee is a qualified charitable institution before transferring funds to the payee provides a significant improvement over the prior art charitable check methods and systems. For example, anyone who receives such a check has the option of entering, as the payee, any qualified charitable institution they wish. None of the prior art methods and systems teach this. Rather, all of the prior art systems and methods rely on a predetermined and static list of allowable payees.

One particular exemplary use of the present methods and systems is discussed at page 8, lines 1-6 of the present specification. In this environment of use, an elementary school is presented with a number of checks to distribute to students. The students can then research and give a donation, using the checks, to any qualified charitable institution.

Thus, the present checks allow the students maximum freedom to make a donation to any institution they wish. If the allowable charitable institutions were limited to a small subset of the institutions qualified under the U.S. IRS code, parents or the students' caregivers could be more likely to complain that the list is discriminatory. However, by allowing the checks to be used for any qualified institution, the students' teachers can give the students full freedom in deciding on a charity without the appearance of discrimination; an otherwise difficult task in today's politically-correct environment.

CLEAR ERRORS IN EXAMINER'S REJECTIONS

Rejections

Claims 1-2 stand rejected under 35 U.S.C. § 103(a) as being obvious over Katz in view of Alcorido and Claims 3-14 stand rejected under 35 U.S.C. 102(b) as being anticipated by Katz. In the present rejections, as with all of the outstanding rejections, the Examiner only cites "col. 3, line 35 to co. 4, line 14; col. 5, line 40 to col. 6, line 44; and fig. 2 – all" as supporting the rejections. See Office Action dated July 14, 2004, pp. 4-7.

For purposes of the rejections, Applicant assumes that the Examiner is referring to the Katz reference. Thus, the Examiner does not cite to any specific portion of the Alcorido reference in support of the outstanding rejections.

Applicant does not rely on the Examiner's citation style as a "clear error" for supporting the present Request. Rather, Applicant merely notes the citation of the references for aiding the reader in understanding the following discussion of the outstanding rejections

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and clear errors. Set forth below, Applicant has presented separate sections identifying claim recitations that are not shown in the prior art.

“A Notice On A Reverse Side Of The Negotiable Check That The Check Must Not Be Presented For Payment By Any Entity That Is Not A Qualified Charitable Institution”

This recitation appears in Claims 1, 2, 13, and 14. However, this feature is not taught in either Katz or Alcorido. As noted above, the Examiner cites to (col. 3, line 35 to co. 4, line 14; col. 5, line 40 to col. 6, line 44; and fig. 2 – all) as supporting the rejections of these claims. However, nothing in either Katz or Alcorido teaches this feature. Thus, any rejection of Claims 1, 2, 13, and 14 cannot be maintained.

Confirming That Said Payee Is A Qualified Charitable Institution Under United States Internal Revenue Code; And Transferring Funds From Said Payor Institution Bank To Said Recipient Qualified Charitable Institution *After* The Payee Has Been Confirmed To Be A Qualified Charitable Institution

This feature is recited in Claim 1, which stands rejected as being obvious over Katz and Alcorido. See page 3 of the outstanding Final Office Action dated February 24, 2005.

Firstly, in finally rejecting Claim 1, the Examiner refers to the explanation set forth in the Office Action dated July 14, 2004. In that Office Action, the Examiner cites to “col. 3, line 35 to co. 4, line 14; col. 5, line 40 to col. 6, line 44; and fig. 2 – all,” which as noted above, Applicant assumes is a cite to the Katz reference.

Nowhere in these cited portions, or any where in either the Katz or Alcorido references, is there a discussion of checking to ensure that the payee is a qualified charitable institution under the United States Code *before* the funds are transferred to the payee identified on the check. Thus, there is a clear error in providing a prior art reference that teaches this feature of Claim 1.

In the outstanding Final Office Action (dated February 24, 2005), the Examiner supplements the rejection of Claim 1 with the explanation, “it would have been obvious to one having ordinary skill in the art at the time of the invention was made to confirm the identity of the payee under the United States Revenue Code to prevent issuing a check containing personal information to someone whose intent is to commit fraud.”

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Applicants do not understand this reasoning. In any event, under the method recited in Claim 1, the payee would already have had possession of the check by the time the status of the payee is checked against the United States Revenue Code. Thus, confirming the identity of the payee under the United States Revenue Code would not “prevent issuing a check containing personal information to someone whose intent is to commit fraud,” because the payee would already have possession of the check.

Thus, Applicants submit that the Examiner has (1) clearly failed to provide a reference that teaches this feature of Claim 1, and (2) has clearly failed to provide any motivation for one of ordinary skill in the art to make the combination recited in Claim 1.

Comparing An Identity Of Said Drawee With A List Of Qualified Charities Under United States Internal Revenue Code *Before* The Philanthropy Check Is Honored By The Drawee Of Said Philanthropy Check

This feature is recited in Claim 3 and is also recited, with reference to payees, in a substantially similar manner in Claim 9. In rejecting Claims 3 and 9 as being anticipated by Katz, the Examiner again cites to “col. 3, line 35 to col. 4, line 14; col. 5, line 40 to col. 6, line 44; and fig. 2 – all.” (assumed to be the Katz disclosure).

However, nowhere does the Katz reference teach confirming the identity of a payee or drawee as a qualified charitable institution under the United States Code, *before* honoring the check. Thus, the present Anticipation rejection cannot be sustained.

In the outstanding Final Office Action, the Examiner supplements this rejection with the statement “it is inherent that a user *may* compare the identity of the charity with a list of qualified charities under the United States Code to prevent issuing a check containing personal information to someone whose intent is to commit fraud.” See page 2, last full paragraph of the outstanding Final Office Action (dated February 24, 2005) (emphasis added).

Applicants note that the Examiner has not established that the Katz reference *necessarily* includes the steps of “comparing an identity of said drawee with a list of qualified charities under United States Internal Revenue Code before the philanthropy check is honored by the drawee of said philanthropy check.” Thus, to the extent that the present rejections rely on inherency, these rejections clearly cannot be sustained.

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Filling In By The Consumer Or By Any Recipient Who Receives The Philanthropy Check
Originally Issued To Said Consumer, The Name Of A Second Charitable Institution That Is
A Qualified Charitable Institution Under United States Internal Revenue Code As Drawee
Of Said Philanthropy Check

This feature is recited in Claim 4, which stands rejected as being anticipated by Katz. See page 2 of the outstanding Final Office Action.

As established above, the Katz reference does not make any reference whatsoever to the United States Internal Revenue Code. Further, the Examiner has not established that the methods and devices taught therein include any reference to the confirmation of a payee or drawee as a qualified charitable institution under United States Internal Revenue Code.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the outstanding Office Action are inapplicable to the present claims. Accordingly, early issuance of a Notice of Allowance is most earnestly solicited.

Respectfully submitted,

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Dated: July 25, 2005

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